

Remarks

In the pending Office Action, the Examiner requests that Applicant restrict the claims in accordance with 35 U.S.C. §121. Claims 1-46 were originally presented for Examination. Claims 47-66 are added by way of the present Response. Claims 1-66 and are currently pending, of which, claims 1, 11, 23, 34, 42, 47 and 57 are in independent form. Favorable reconsideration of the present Response as currently constituted is respectfully requested.

Regarding Applicant's Election

Applicant elects with traverse the subject matter of Group I, claims 1-10, i.e., the claims drawn to a method for executing a trade in a user preferred security.

Regarding the Restriction Requirement

Applicant respectfully traverses the Restriction Requirement. With respect to Group I and Group II, the Examiner uses MPEP §806.05(d) as the basis for the Restriction Requirement. Applicant respectfully submits that under MPEP §806.05(d) the Examiner "must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, "the burden is on the Examiner to provide an example." See MPEP §806.05(d).

In paragraph 2, the Examiner states that the invention of Group I relates to a method for executing a trade in a user

preferred security. The Examiner follows this statement by listing the limitations of claim 1. The Examiner states that the invention of Group II relates to a method for executing a trade in a user preferred security. The Examiner follows this statement by listing the limitations of claim 11. The Examiner follows these remarks with the following statement:

The steps of the two methods are very clearly different and so is the scope and utility of the two inventions. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Applicant respectfully submits that the Examiner has not satisfied his burden under MPEP §806.05(d) as no example is provided that illustrates the utility of one of the subcombinations over the other subcombination. Neither the listing of the elements contained in claims 1 and 11 nor the closing remarks present an example as required by the MPEP.

Further, the claims of Group I and Group II define the same essential characteristics of a single disclosed embodiment of the invention and restriction should not be required. See MPEP §806.03. For the Examiner's convenience, claim 1 of Group I and claim 11 of Group II are juxtaposed to illustrate that the claims of Group I and Group II are but different definitions of the same disclosed subject matter. Claim 1 of Group I and Claim 14 of Group II read as follows (Please note that the differences between the claims are bolded.):

<p>1. (Original) A method for executing a trade in a user preferred security comprising the steps of:</p> <ul style="list-style-type: none"><li>representing the user preferred securities in an N dimensional graph on a client system;</li><li>selecting one of the user preferred securities from the N dimensional graph;</li><li>associating order parameters with the selected user preferred security;</li><li>sending an order to trade the selected user preferred security from the client system to a server system; and</li><li>routing the order from the server system to a trade execution location.</li></ul>	<p>11. (Withdrawn) A method for executing a trade in a user preferred security comprising the steps of:</p> <ul style="list-style-type: none"><li>providing security data for a plurality of securities to a server system from a security data source;</li><li>transmitting user specific criteria from the client system to the server system;</li><li>analyzing the security data for the plurality of securities based upon the user specific criteria to identify the user preferred securities in the server system;</li><li>designating N user specific parameters of the security data in the client system, wherein N is a positive integer;</li><li>representing the user preferred securities in an N dimensional graph on the client system based upon the N user specific parameters;</li><li>selecting one of the user preferred securities from the N dimensional graph;</li><li>associating order parameters with the selected user preferred security;</li><li>sending an order to trade the selected user preferred security from the client system to the server system; and</li><li>routing the order from the server system to a trade execution location.</li></ul>
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Claim 11 is identical to claim 1, but for the addition of the four bolded limitations in claim 11. Hence, claim 1 and claim 11 are different definitions of the same disclosed subject matter. Moreover, claim 11 and claim 1 vary in only breadth or scope of definition. Accordingly, Applicant respectfully submits that under MPEP §806.03 the restriction requirement is not proper. Applicant respectfully requests that the claims of Group I and Group II be considered in the same application.

With respect to Group I and Group III, the Examiner uses MPEP §806.05(d) as the basis for the Restriction Requirement. Again, Applicant respectfully submits that under MPEP §806.05(d) the Examiner "must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, "the burden is on the Examiner to provide an example." See MPEP §806.05(d).

In paragraph 2, the Examiner states that the invention of Group I relates to a method for executing a trade in a user preferred security. The Examiner follows this statement by listing the limitations of claim 1. The Examiner then states that the invention of Group III relates to a system for executing a trade in a user preferred security. The Examiner follows this statement by listing the limitations of claim 23. The Examiner follows these remarks with the following statement:

The method of Invention I can be implemented using a system with a configuration different from what is claimed in Invention III, and hence the method has utility different from what is claimed in Invention III. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Applicant respectfully submits that the Examiner has not satisfied his burden under MPEP §806.05(d) as no example is provided that illustrates the utility of one of the subcombinations over the other subcombination. Neither the listing of the elements

contained in claims 1 and 23 nor the closing remarks present an example as required by the MPEP.

Further, the claims of Group I and Group III contain no material difference and restriction should not be required. See MPEP §806.05(e). Both claim 1 and claim 23 include limitations directed to representing the user preferred securities in an N dimensional graph and selecting one of the user preferred securities from the N dimensional graph. Additionally, in both claims, the client system provides the server system with user order parameters to route the order from the server system to a trade execution location. Hence, the method claims of Group I and apparatus claims of Group III are not distinct inventions and restriction requirement is not required.

With respect to Group I and Group IV, the Examiner uses MPEP §806.05(d) as the basis for the Restriction Requirement. Similar to the previously discussed basis for the Restriction Requirement, Applicant respectfully submits that under MPEP §806.05(d) the Examiner "must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, "the burden is on the Examiner to provide an example." See MPEP §806.05(d).

In paragraph 2, the Examiner states that the invention of Group I relates to a method for executing a trade in a user preferred security. The Examiner follows this statement by listing the limitations of claim 1. The Examiner then states that the

invention of Group IV relates to a computer program embodied on a computer readable medium on a server system for executing a trade in a user preferred security. The Examiner follows this statement by listing the limitations of claim 34. The Examiner follows these remarks with the following statement:

The method of Invention I can be implemented using a computer program different from what is claimed in Invention IV, and hence the method has utility different from what is claimed in Invention IV. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group IV, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Applicant respectfully submits that the Examiner has not satisfied his burden under MPEP §806.05(d) as no example is provided that illustrates the utility of one of the subcombinations over the other subcombination. Neither the listing of the elements contained in claims 1 and 34 nor the closing remarks present an example as required by the MPEP.

Further, the claims of Group I and Group IV contain no material difference and restriction should not be required. See MPEP §806.05(e). Both claim 1 and claim 34 include limitations directed to representing the user preferred securities in an N dimensional graph and selecting one of the user preferred securities from the N dimensional graph. Additionally, in both claims, the client system provides the server system with user order parameters to route the order from the server system to a trade execution location. Hence, the method claims of Group I and

computer program claims of Group IV are not distinct inventions and restriction requirement is not required.

With respect to the other pairings ( e.g., Group I and Group V; Group II and Group III; Group II and Group III; and Group II and Group IV), the Examiner offers the following explanation in support of the Restriction Requirement:

Similarly other pairing of inventions stated above are related as sub combinations disclosed as usable together in a single combination. These inventions are distinct from each other as can be evident from the definition of the groups described above. Also they require separate searches and hence restriction of these inventions for examination purposes as indicated is proper.

Applicant respectfully submits that in accordance with MPEP §806.05(d) the Examiner "must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." This explanation does not satisfy the Examiner's duty. Accordingly, in view of the foregoing, Applicant respectfully requests the Examiner withdraw the Restriction Requirement.

#### New Claims

Claims 47-66 have been added by way of the present Response. Claims 47-56 are means claims for practicing the methods of claims 1-10. Accordingly, claims 47-56 are linking claims per MPEP §806.05(e) and §809.04 that must be examined with the election of Group I, claims 1-10. Further, Applicant respectfully submits that

if claims 47-56 are ultimately allowed, a rejoinder of the claims of Group III is required.

Claims 57-66 are computer program claims for practicing the methods of claims 1-10. Accordingly, claims 57-66 are linking claims per MPEP §806.05(e) and §809.04 that must be examined with the election of Group I, claims 1-10.

#### Fee Statement

The number of independent claims has increased by two by way of the present Response. The total number of claims has increased by 20 by way of the present Response. Accordingly, Applicant has submitted form PTO-2038 authorizing payment in the amount of \$532.00. If additional fees are due or an overpayment has been made, please debit or credit our deposit account, Account No. 03-1130.

#### Conclusion

In view of the forgoing, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection requirement to the claims presented for consideration herein. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.



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Respectfully submitted:



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